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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,763	10/17/2001	William Sanford	11009-0021	8838

22865 7590 06/15/2005  
ALTERA LAW GROUP, LLC  
6500 CITY WEST PARKWAY  
SUITE 100  
MINNEAPOLIS, MN 55344-7704

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/981,763

Applicant(s)

SANFORD, WILLIAM

Examiner

Nasser Ahmad

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1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 28, 2005 has been entered.

### ***Rejections Withdrawn***

2. Claims 30-33 rejected under 35 USC 103(a) as being unpatentable over Heuser in view of the amendment filed on February 28, 2005.

3. Claims 34-35 rejected under 35 USC 103(a) as being unpatentable over Cunningham in view of Heuser in view of the amendment.

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 32-35 and newly submitted claims 36-37 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heuser.

Heuser relates to an alignable label comprising a label having a long and a short dimension, a backing member applied to the label and having a split along its short dimension, and a transparent laminate removably attached to the other side of the backing member (see figure-3). The label and the laminate are straddling the split line. The label can be printed as shown in figure-4. However, Heuser fails to teach that the split line is along the long dimension. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Heuser by providing the split line along its long dimension, instead of the short dimension, as it would still provide the same function of facilitating removability of the label from the cover laminate, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

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Further, the phrases “for a folder ...a curvature”, “to conform ...the folder”, etc. have not been given any patentable weight because said phrases are directed to intended future use of the claimed label and does not constitute a positive limitation.

7. Claims 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham (3691662) in view of Heuser.

Cunningham discloses a laminated tab index for folders wherein the index tab is applied to the folder's edge by removing the tab label from a backing member, aligning the label with the edge, and folding the label over the edge of the folder. However, Cunningham fails to teach that the label index tab backing member has a split line for separating the label. Heuser, as discussed above, teaches the advantage of using a label backing with a split line for separating the label from its carrier. Therefore, it would have been obvious to having ordinary skill in the art to utilize Heuser's teaching of using a split line in the invention of Cunningham with the motivation to facilitate removability of the label from a carrier substrate.

8. Claims -37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heuser.

Heuser, as discussed above, fails to teach that the shaped section is “S”-shaped. It would have been obvious matter of design choice to modify Heuser by providing its shaped section to have an “S” shape for design appeal, since such a change would have involved a mere change in the shape of the section. A change in shape is

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generally recognized to be within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

In the absence of any showing of criticality by the applicant, the shaped edge of figure-4 of the instant application is obviously functionally equivalent to figure-1 in the instant application.

9. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cunningham in view of Heuser.

Cunningham and Heuser, as discussed above, fails to teach that the shaped section is "S"-shaped. It would have been an obvious matter of design choice to modify Heuser by providing its shaped section to be "S"-shaped for design appeal, since such a change would have involved a mere change in the shape of the section. A change in shape is generally recognized to be within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

In the absence of any showing of criticality by the applicant, the shaped edge of figure-4 is deemed to be obvious functional equivalent of figure-1 in the instant application.

### ***Response to Arguments***

10. Applicant's arguments filed February 28, 2005 have been fully considered but they are not persuasive.

Applicant argues that claim 32 has been amended to include the limitation of a folder having a curved edge, and neither Heuser nor Cunningham teaches said limitation. This

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is not found to be convincing because the phrases “for a folder ...a curvature”, “to conform...the folder”, etc. are directed to an intended future use of the claimed label and hence, does not constitute a positive limitation as argued.

Applicant should note that, in the absence of any showing of criticality, the shape of the alignment section being curved or straight line shaped would have been obvious functional equivalence as said section would still perform the same function of aligning the label to a substrate. Similarly, the curved shape would include “S” shape as recited in claims 36 and 37.

Thus, in the absence of any evidence to the contrary, it remains the examiner's position that the instant claimed invention would have been obvious over the prior art of record as discussed above.

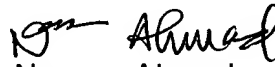
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
June 13, 2005.